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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group: 3627 }
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Confirmation No.: 1918 }
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Application No.: 09/903,001 }
 }
Invention: AUDIO/VIDEO AUTOMATED }
 PAYMENT FACILITY }
 }
Applicant: Mark Pratt et al. }
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Filed: July 11, 2001 }
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Attorney }
Docket: 37837-75702 }
 }
Examiner: Florian M. Zeender }

ELECTRONICALLY
SUBMITTED ON:
JANUARY 29, 2007

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is electronically submitted for the application identified above in support of the appeal from the June 28, 2006 rejection of claims 1-13. Appellants hereby petition for a two-month extension of time to extend the deadline for filing this brief from November 28, 2006 to January 29, 2007 (note January 28, 2007 fell on a Sunday). In this regard, it is respectfully requested that this paper be considered as a TWO-MONTH Petition for an Extension of Time sufficient to effect a timely filing of this brief. Please charge the fee for this extension of time (\$225) to the Account of Barnes & Thornburg, Deposit Account No. 10-0435 with reference to file 37837-75702. Because this is a reinstatement of an appeal not acted on by the Board of Appeals as a result of prosecution being reopened by the Primary Examiner, it is

believed that the fees previously paid for the filing of the original Appeal Brief on April 18, 2006 will be applied to cover the costs associated with this Notice. Because the fees remain unchanged (\$250.00), it is believed no additional fees are due in conjunction with this paper. If this is not the case, Applicants hereby authorize the Commissioner to charge any additional fees which may be required to Deposit Account No. 10-0435.

REAL PARTY IN INTEREST

The real parties in interest are the inventors Mark Pratt and David Harpold.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants that will directly affect or be directly affected by, or have a bearing on the Board's decision in the present appeal.

STATUS OF CLAIMS

Claims 1-13 were rejected in the Office Action dated June 28, 2006 and are appealed. A copy of the appealed claims is attached hereto in a Claims Appendix.

STATUS OF AMENDMENTS

No amendment has been filed subsequent to the final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1

Claim 1 is directed to an automated payment system for a parking facility. Such a system is used to collect payment from the drivers of vehicles exiting the parking facility (e.g., a parking garage) without the use of a live attendant located in a tollbooth at the exit of the parking facility. The system includes an exit gate (11) operable to control egress from the parking facility. The system also includes a payment terminal (20) that includes means for assessing a payment amount (paragraph [0021]) which may be exemplarily embodied as a ticket reader (28), a processor (65) for calculating a time duration and associated fee, and a display (30) for

displaying the fee amount to a customer. The payment terminal also includes means for receiving the payment amount (paragraph [0022]) which may be exemplarily embodied as a credit/debit card reader (32) and/or a cash acceptor (33) along with the associated software for processing the payment. The payment terminal also includes means for opening the exit gate upon receipt of the payment amount (paragraphs [0006] and [0019]) which may exemplarily be accomplished by the processor (65) generating an instruction on the gate signal line 68 to raise the gate (11). The automated payment system also includes means for providing two-way video and audio communication with a monitoring facility (75) remote from said payment terminal (paragraphs [0024]-[0041]). This means may be exemplarily embodied as a digital video camera (40), a monitor (42), a speaker 43, and a microphone (44) along with the associated hardware and software.

Independent Claim 5

Claim 5 is directed to an automated payment system for a plurality of parking facilities. Such a system is used to collect payment from the drivers of vehicles exiting each of the plurality of parking facilities (e.g., a parking garage) without the use of a live attendant located in a tollbooth at the exit of each of the parking facilities. The automated payment system includes a central monitoring facility (75) (FIG. 3, paragraphs [0034]-[0041]). The automated payment system also includes a plurality of exit facilities (10) remote from said central monitoring facility. Each of the exit facilities controls egress from a corresponding one of the plurality of parking facilities (paragraphs [0019]-[0023], FIG. 1). The automated payment system also includes a payment terminal (20) at each of said plurality of exit facilities (10). Each payment terminal has means for assessing and receiving payment (paragraphs [0021]-[0022]) which may be exemplarily embodied as a ticket reader (28), a processor (65) for calculating a time duration and associated fee, a display (30) for displaying the fee amount to a customer, a credit/debit card reader (32) and/or a cash acceptor (33) along with the associated software for processing the payment. The automated payment system also includes means for providing two-way video and audio communication between said central monitoring facility and said payment terminal at each of said plurality of exit facilities (paragraphs [0024]-[0041]). This means may

be exemplarily embodied as (a) a digital video camera (40), a monitor (42), a speaker 43, and a microphone (44) located at the payment terminal, and (b) a PC (79), video camera (80), and a speaker/microphone system (81) located at the central monitoring facility, along with the associated hardware and software.

Independent Claim 10

Claim 10 is directed to an automated payment system for a facility. The system includes an apparatus (28, 65) for calculating a payment amount (paragraph [0021]) and an apparatus (32, 33) for receiving the payment amount (paragraph [0022]). The automated payment system also includes a gate apparatus (11) operable to control access to the facility in response to receipt of the payment amount (FIG. 1, paragraph [0006]). The automated payment system also includes a two-way video and audio communication system linking the automated payment system with a monitoring facility remote from the automated payment system (paragraphs [0024]-[0041]).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The following two grounds of rejection are presented for review:

(1) the rejection under 35 U. S. C. § 103(a) of claims 1, 2, 4-6, 8-11, and 13 as being obvious over U.S. Patent No. 4,603,390 issued to Mehdipour (hereinafter "Mehdipour") in view of U.S. Patent No. 6,032,126 issued to Kaehler (hereinafter "Kaehler").

(2) the rejection of under 35 U. S. C. § 103(a) of claims 3, 7, and 12 as being obvious over Mehdipour in view of Kaehler and further in view of U.S. Patent No. 6,584,380 issued to Murphy (hereinafter "Murphy").

ARGUMENT

I. The Board Is Urged to Reverse the First Ground of Rejection.

The claims within the first ground of rejection will be separately argued in the following groups:

Group A – claims 1, 5, and 10

Group B – claims 2, 6, and 11

Group C – claims 4, 8, 9, and 13

A. A Prima Facie Case of Obviousness Has Not Been Established in Regard to Claims 1, 5, and 10

A prima facie case of obviousness has not been established in regard to claims 1, 5, and 10 since the combination of Mehdipour and Kaehler does not arrive at the invention of claims 1, 5, and 10, nor has the Examiner put forth a legally sufficient teaching, motivation, or suggestion for combining Mehdipour with Kaehler.

The proposed combination of Mehdipour and Kaehler does not arrive at the invention of claims 1, 5, and 10 since it does not include each and every limitation of claims 1, 5, and 10. This is true since, amongst other things, the proposed combination does not include two-way video and audio communication between a monitoring facility and payment terminal (in the case of claims 1 and 5) or an automated payment system (in the case of claim 10). Mehdipour is directed largely to a system for tracking vehicle license plate numbers within a garage. The Examiner admits that Mehdipour lacks “the specific teaching of providing two-way video and audio communication between the central monitoring facility and the payment terminal”. (see 6/28/06 Office Action, page 2, last four lines). Kaehler is directed to automated fuel dispensers, and does not cure the deficiencies of Mehdipour when combined therewith. Namely, Kaehler teaches fuel dispensers which are fed an audio/video signal featuring a promotional message from a video cassette recorder or laser disc during use of the fuel dispenser by a user. When the user of the fuel dispenser signals for assistance, the promotional message is interrupted, and an audio/video signal featuring a customer service operator is fed to the fuel dispenser. Once the customer service operator has initiated communication with the user of the fuel dispenser, the

user orders non-fuel items by use of a microphone 40 in a manner similar to as in a drive-through retail setting. (see Kaehler column 1, lines 20-24 and column 5, lines 33-67). *However, the fuel dispensers of Kaehler do not include video cameras or any other type of device to capture and transmit images of the user of the fuel dispenser to the customer service operator, thereby making two-way video impossible. In other words, like a drive-through restaurant after which it is modeled, the system of Kaehler utilizes two-way audio (and even incorporates one-way video), but it fails to utilize two-way video.* The initial burden for establishing that a proposed combination includes all of the elements is on the Examiner, and, in the absence of such, a prima facie case of obviousness cannot be established.

Even if the proposed combination of Mehdipour and Kaehler could be shown to arrive at the invention of claims 1, 5, and 10, a notion that Appellants disagree with, there is no legally sufficient teaching, suggestion, or motivation to combine such references. The rule of law for a finding of obviousness under 35 U.S.C. § 103(a) was reiterated recently by the Court of Appeals for the Federal Circuit as follows, “[w]hen patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.” In re Lee, 277 F.3d 1338 at 1343, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002); See also McGinley v. Franklin Sports, Inc., 262 F.3d 1339 at 1351-52, 60 USPQ2d 1001 (Fed. Cir. 2001) (“the central question is whether there is reason to combine [the] references,” a question of fact drawing on the Graham factors). The Federal Circuit expounded upon the necessity of finding some teaching or motivation to combine the references in the references themselves concluding that “[t]he factual inquiry whether to combine references must be thorough and searching.” In re Lee, 61 U.S.P.Q.2d at 1433 (Fed. Cir. 2002). The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to

why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

In an apparent attempt to establish a case of obviousness based on these references, the Examiner stated that:

“It would have been obvious to modify Mehdi-pour ... in view of Kaehler ... in order to allow the customer to initiate and complete an extended transaction (i.e., payment for an outstanding monthly parking pass; see Mehdi-pour, Col. 3, lines 14-23) yielding added convenience to the customer (See Kaehler, Col. 1, lines 29-31).” (see 6/28/06 Office Action, page 3, second paragraph).

This is insufficient for a number of reasons. Firstly, the Examiner points to a passage of Kaehler, column 1, lines 19-31, which describes how the system of Kaehler provides advantages to the user of the fuel dispenser (e.g., “permitting the customer to initiate and complete a extended transaction...”, “yielding added convenience”), and appears to be of the belief that sufficient motivation will exist for combination if Mehdi-pour in some way contemplates “extended transactions”. As such, the Examiner then points to a section of Mehdi-pour, i.e., column 3, lines 14-23, as being directed to a need to facilitate a customer’s completion of “extended transactions.” However, this section of Mehdi-pour teaches nothing more than the notion that a printer can be used to print a statement of charges for monthly parkers. Such a process could hardly be construed as an “extended transaction”, and certainly not one performed by the customer since a careful reading of this section describes how such a printed statement is sent to the owner of the vehicle (i.e., the customer). *In other words, the purported “extended transaction” is not even performed by the customer, but rather is performed by the cashier.*

This line of reasoning is troubling for a number of reasons. Most notably, it is simply a repeat exercise in the use of conclusory, unsupported statements as a substitute for the required factual analysis. To wit, in the previously filed Appeal Brief, Appellants pointed out similar flaws in the previous rejection – namely that the primary reference did not include any transaction that could even remotely be considered “an extended transaction”. It appeared that the Examiner had simply fabricated the alleged motivation with no regard for the teachings of the prior art. Now, in lieu of actually reviewing the prior art to find a legally sufficient teaching, motivation, or suggestion for combining the references, the Examiner appears to have gone

shopping through the references for some passage to support the flawed motivation. The presently offered motivation is no more legally sound than the previous one, and serves no purpose but to prolong prosecution of Appellants' application.

In short, even if armed with any one or more of the general notions of "permitting the customer to initiate and complete a extended transaction...", or "yielding added convenience", one skilled in the art would not be led to the very specific combination of Mehdipour and Kaehler purported by the Examiner, and the mere statement of such on the record cannot function as a legally sufficient substitute for the required factual analysis clarified and confirmed in *Lee*. It is the Examiner's burden to point to such motivation, and the Examiner has not done so.

Furthermore, not only has the Examiner not established where the prior art supports his proposed motivation to combine Mehdipour and Kaehler, the motivation itself is insufficient *since it is completely contrary to the teaching of Mehdipour*. Indeed, the Examiner asserts that the motivation would permit "the customer to initiate and complete an extended transaction." However, a careful reading of Mehdipour does not identify a need for such capability *since the customer does not perform any transaction that could even remotely be construed as "extended", to the extent such a term is even understood*. In particular, the system of Mehdipour generally does not interact with the customer, but rather primarily interacts with the cashier. For example, the system "interacts" with the customer when he or she pays for his or her parking when pulling out of the parking garage by either handing cash to the cashier or placing it in a currency acceptor. Neither of these, nor any other interactions with the customer discussed in Mehdipour, could be reasonably construed as an "extended transaction." As pointed out above, the allegedly "extended transaction" identified by the Examiner is nothing more than the printing of an invoice, and isn't even performed by the customer, but rather is done by the cashier. As such, one skilled in the art would clearly not be motivated to go to the relatively high expense and effort to incorporate the audio/video link of Kaehler into the system of Mehdipour to permit the customer to initiate "extended transactions" since such transactions are not even contemplated by the system of Mehdipour. *In other words, no one skilled in the art would spend the literally tens of thousands of dollars to incorporate a two-way audio/video capability*

for the purpose of performing "extended transactions" in a system that does not perform or require extended transactions in the first place. This simply makes no sense.

Because the Examiner has not offered a legally sufficient teaching, motivation, or suggestion to combine Mehdipour with Kaehler, and in light of the reasons against such a combination, it appears that the Examiner is using the Appellant's application as a roadmap in developing his rejection. That is, the Examiner appears to be using hindsight reconstruction as a substitute for a factual basis for the rejection of the claims under 35 U.S.C. §103. Such use of hindsight reconstruction is not proper. "There must be a reason apparent at the time the invention was made to a person of ordinary skill in the art for applying the teaching at hand, or the use of the teaching as evidence of obviousness will entail prohibited hindsight." *In re Nomiya, Kohisa, and Matsumura*, 509 F.2d 566, 184 USPQ 607 (CCPA 1975). "The Patent Office has the initial duty of supplying a factually basis for a rejection under 35 U.S.C. § 103. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis." *In re Rice*, 481 F.2d 1316, 178 USPQ 478, 479 (CCPA 1973).

Based on the above, the Examiner has not established a prima facie case of obviousness with regard to Appellants' claims 1, 5, and 10. As such, the rejection of claims 1, 5, and 10 should be overturned.

B. A Prima Facie Case of Obviousness Has Not Been Established in Regard to Claims 2, 6, and 11

A prima facie case of obviousness has not been established in regard to claims 2, 6, and 11 since the Examiner has not shown how the combination of Mehdipour and Kaehler arrives at the invention of claims 2, 6, and 11. Indeed, the record is completely devoid of any assertion by the Examiner as to where the proposed combination teaches two-way video and audio communication that includes an Ethernet or Internet link between the payment terminal and the monitoring facility. By the Examiner's own admission, Mehdipour does not teach using video and audio two-way communication. In formulating his rejection, he relies on Kaehler to overcome such a deficiency in Mehdipour. However, Kaehler does not disclose the use of two-

way video and audio communication that includes an Ethernet or Internet link. In other words, neither reference alone or in combination teaches such a feature.

The Examiner relies on the use of Official Notice as being known in the art for “communication between processors”, and then modifies the Mehdipour/Kaehler to include them “to provide efficient and/or high speed data transmission”. This is flawed for a number of reasons. Most notably, even though such technologies may have been known, it does not follow that all systems would incorporate such technologies. This is well exemplified in the case of the system of Kaehler. Kaehler appears to enjoy a relatively simply network configuration that satisfies the needs of its relatively local application. It does not necessarily follow that one skilled in the art would find it obvious to incorporate the advanced technologies identified by the Examiner in light of the relative simplicity of the Kaehler system, especially in light of the added costs of doing so. Because of this, the Examiner has not established a prima facie case of obviousness with regard to Appellants’ claims 2, 6, and 11. As such, the rejection of claims 2, 6, and 11 should be overturned.

C. A Prima Facie Case of Obviousness Has Not Been Established in Regard to Claims 4, 8, 9, and 13

A prima facie case of obviousness has not been established in regard to claims 4, 8, 9, and 13 since the Examiner has not shown how the combination of Mehdipour and Kaehler arrives at the invention of such claims. The record is completely devoid of any assertion by the Examiner as to where the proposed combination teaches a data link for the remote control of the payment terminal’s processor. The section Mehdipour identified by the Examiner, i.e., FIG. 2 and its corresponding discussion in column 19, lines 17-20, merely indicates that the computer 34 may be connected to a main frame computer 60 to “keep track of a number of parking facilities”. There is no teaching whatsoever that the main frame computer *controls* any aspect of the computer. The Examiner has not identified how Kaehler cures such a deficiency. Because of this, the Examiner has not established a prima facie case of obviousness with regard to Appellants’ claims 4, 8, 9, and 13, and the rejection of such claims should be overturned.

D. Conclusion in Regard to the First Ground of Rejection

Based on the above, the Examiner has not established a proper §103 rejection with regard to Appellant's claims 1, 2, 4-6, 8-11, and 13. As such, the rejection of such claims should be reversed.

II. The Board Is Urged to Reverse the Second Ground of Rejection.

A Prima Facie Case Obviousness Has Not Been Established in Regard to Claims 3, 7, and 12

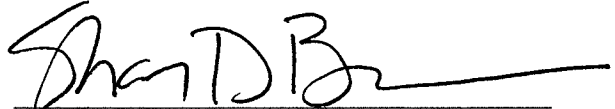
A prima facie case of obviousness has not been established in regard to claims 3, 7, and 12 since the Examiner has not provided a legally sufficient teaching, motivation, or suggestion for combining the references. In particular, in the 6/28/06 Office Action, the Examiner indicated that "[i]t would have been obvious to modify Mehdi pour ... in view of Kaehler ... in view of Murphy ... in order to have control of the camera". The purported motivation offered by the Examiner (i.e., "to have control of the camera") is nothing more than an unsupported, conclusory statement that cannot function as a substitute for the legally required factual analysis. The use of such a statement suggests that the rejection of claims 3, 7, and 12 was made entirely by the improper use of hindsight. Because of this, the Examiner has not established a prima facie case of obviousness with regard to Appellants' claims 3, 7, and 12, and the rejection of such claims should be overturned.

III. Summary Conclusions

Accordingly, it is submitted that the 35 U. S. C. § 103 rejections of claims 1-13 are erroneous. The Board is thus urged to reverse those rejections. Such action is respectfully requested.

Respectfully submitted,

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CLAIMS APPENDIX

1. An automated payment system for a parking facility, comprising:
an exit gate operable to control egress from the parking facility; and
a payment terminal including;
 - means for assessing a payment amount;
 - means for receiving the payment amount;
 - means for opening said exit gate upon receipt of the payment amount; and
 - means for providing two-way video and audio communication with a monitoring facility remote from said payment terminal.
2. The automated payment system according to claim 1, wherein said means for providing two-way video and audio communication includes an Ethernet or Internet link between said payment terminal and the monitoring facility.
3. The automated payment system according to claim 2, wherein said means for providing two-way video and audio communication includes an IP-addressable video camera.
4. The automated payment system according to claim 1, further comprising:
 - a processor at said payment terminal operable to control said means for assessing and said means for receiving; and
 - a data link between said processor and the monitoring facility to permit remote control of said processor.
5. An automated payment system for a plurality of parking facilities comprising:
 - a central monitoring facility;
 - a plurality of exit facilities remote from said central monitoring facility, each controlling egress from a corresponding one of the plurality of parking facilities;
 - a payment terminal at each of said plurality of exit facilities, each having means for assessing and receiving payment; and
 - means for providing two-way video and audio communication between said central monitoring facility and said payment terminal at each of said plurality of exit facilities.
6. The automated payment system according to claim 5, wherein said means for providing two-way video and audio communication includes an Ethernet or Internet link between said payment terminal and the monitoring facility.

7. The automated payment system according to claim 6, wherein said means for providing two-way video and audio communication includes an IP-addressable video camera.

8. The automated payment system according to claim 5, further comprising:
a processor at said payment terminal operable to control said means for assessing and said means for receiving; and
a data link between said processor and the monitoring facility to permit remote control of said processor.

9. The automated payment system according to claim 9, further comprising:
a central processor at said central monitoring facility connected to said processor at said payment terminal through said data link and controllable at said central monitoring facility to control said processor at said payment terminal.

10. An automated payment system for a facility, comprising:
an apparatus for calculating a payment amount;
an apparatus for receiving the payment amount;
a gate apparatus operable to control access to the facility in response to receipt of the payment amount; and
a two-way video and audio communication system linking the automated payment system with a monitoring facility remote from the automated payment facility.

11. The automated payment system according to claim 10, wherein said means for providing two-way video and audio communication includes an Ethernet or Internet link between said payment terminal and the monitoring facility.

12. The automated payment system according to claim 11, wherein said means for providing two-way video and audio communication includes an IP-addressable video camera.

13. The automated payment system according to claim 11, further comprising:
a processor operable to control said means for assessing and said means for receiving; and
a data link between said processor and the monitoring facility to permit remote control of said processor.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.